

REMARKS

Applicant hereby responds to the Final Office Action dated July 23, 2008. Applicant thanks the Examiner for carefully considering the application.

Status of Claims

Claims 1-15 were, and remain currently pending. Claims 1 and 12 are independent.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,698,020 issued to Zigmond ("Zigmond") in view of U.S. Patent No. 5,838,314 issued to Neel ("Neel") and further in view of U.S. Patent No. 6,282,713 issued to Kitsukawa et al. (Kitsukawa). Claims 5, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Neel in view of Kitsukawa, and further in view of U.S. Patent No. 7,039,935 issued to Knudson ("Knudson"). Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Neel in view of U.S. Patent Application Pub. No. 2004/0073947 for Gupta ("Gupta") and U.S. Patent No. 6,469,749 issued to Dimitrova ("Dimitrova"). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond, Neel and Knudson in view of Gupta and Dimitrova.

Claim Amendments

By way of this reply, claims 1 and 12 are amended for clarification. No new matter has been added by way of these amendments and none of the amendments is made in view of prior art.

Rejections Under 35 U.S.C. 103(a)

Claims 1-4 and 6-8

Claims 1-4, and 6-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Neel and further in view of Kitsukawa. The rejection is respectfully traversed because for at least the following reasons, Zigmond, Neel, Kitsukawa, and any combination of the three do not disclose all of the claimed limitations.

According to MPEP §2142,

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). Additionally, according to MPEP §2143,

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Zigmond discloses that after a user views an advertisement a predetermined number of

times that the display of the advertisement is stopped. While the display of the advertisement viewed the predetermined time is stopped, the viewing of content is not disabled.

Distinguishable, Applicant's amended claim 1 requires, in part,

maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then *disabling the digital TV function of outputting the received video data* of the digital television receiver (emphasis added).

Neel is relied on for disclosing that content can be received for free or at a reduced rate if a user responds to an interactive advertisement. Neel, however, does not teach, disclose or suggest that after the count reaches a predetermined number, *disabling the digital TV function of outputting the received video data* of the digital television receiver (emphasis added). Additionally, the questions in an interactive advertisement are still related to a single advertisement. Therefore, there is no determining if a predetermined count of advertisements is reached before disabling a digital TV function.

Kitsukawa is relied on for disclosing combining ads with video. Even if the teachings of Neel and Kitsukawa are combined with those of Zigmond, the result would still not teach, disclose or suggest Applicant's amended claim 1 limitations of,

maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then *disabling the digital TV function of outputting the received video data* of the digital television receiver (emphasis added).

Further, the assertions made in the Office Action on pages 6-8 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2143 cannot be found. Additionally, since neither Zigmond, Neel, Kitsukawa, and therefore,

nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's claim 1, as listed above, Applicant's claim 1 is not obvious over Zigmond in view of Neel and further in view of Kitsukawa since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claim 1 of the present application is patentable over Zigmond and Neel in further view of Kitsukawa for at least the reasons set forth above. Additionally, the claims that directly or indirectly depend on amended claim 1, namely claims 2-4 and 6-8, are also patentable over Zigmond and Neel in further view of Kitsukawa for at least the same reasons as asserted above.

Regarding Applicant's claim 2, it is asserted in the Office Action that Zigmond discloses Applicant's claim 2 limitations of "after the digital TV function has been disabled, such that video data from the digital television service provider are no longer output, storing a new set of a plurality of advertisement messages in the storage device; and subsequently enabling the digital TV function of the digital television receiver" according to column 8, lines 29-39 and column 13 lines 40-47. Applicant respectfully disagrees. Zigmond simply discloses switching between a video stream and an advertising stream based on a triggering event (column 8, lines 29-39) and blocking a particular advertisement after the particular advertisement has been viewed by a particular user a certain number of times in a certain period of time (column 13, lines 40-47). Nowhere in the cited text of Zigmond are Applicant's claim 2 limitations of "*storing a new set of a plurality of advertisement messages in the storage device; and subsequently enabling the digital TV function of the digital television receiver.*" Thus, claim 2 of the present application is patentable over Zigmond and Neel for at least the reasons set forth above.

Regarding Applicant's claim 4 requires "setting the *predetermined number* such that *all of the plurality of the advertisement messages that were stored will be output.*" It is asserted in the Office Action on page 8 that Zigmond discloses Applicant's claim 4 limitations at column 14, lines 49-58. Applicant respectfully disagrees. Zigmond simply discloses that certain advertisers will have a guaranteed number of exposures. The advertisements of certain advertisers do not encompass all of the stored advertisements in Zigmond. Further, it is clear that the guarantee is

so that an advertiser gets at least the guaranteed amount instead of fewer. But it does not mean there cannot be a greater amount displayed. Simply put, the guaranteed number of exposures does not equal all of the stored advertisements. Thus, claim 4 of the present application is patentable over Zigmond and Neel for at least the reasons set forth above.

Accordingly, withdrawal of the rejections of claims 1-4 and 6-8 are respectfully requested.

Claims 5, 12, 13 and 15

Claims 5, 12, 13 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Neel in view of Kitsukawa and further in view of U.S. Patent No. 7,039,935 issued to Knudson ("Knudson"). The rejection is respectfully traversed because for at least the following reasons, Zigmond, Neel, Kitsukawa, Knudson, and any combination of the four do not disclose all of the claimed limitations.

Applicant's claim 5 directly depends on amended claim 1. As asserted above, neither Zigmond, Neel, Kitsukawa, nor any combination, teach, disclose or suggest Applicant's amended claim 1 limitations. Knudson is relied on for disclosing advertising banners in conjunction with video. However, the banners in Knudson are not combined with the video in an output signal. That is, even if Knudson is combined with the teachings of Zigmond, Neel and Kitsukawa, the result would still not teach, disclose or suggest Applicant's amended claim 1 limitations of,

maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then *disabling the digital TV function of outputting the received video data* of the digital television receiver (emphasis added).

Applicant's amended claim 12 requires in part,

an output terminal connected to said video reconstruction unit for

receiving the combined video output signal and for outputting the combined video output signal, wherein the selected program and rendered data are simultaneously output in the video output signal for simultaneously viewing the advertisement messages and the received video data, wherein *the disable signal disables output of selected programs* (emphasis added).

Similarly as asserted above with regard to claim 1, even if Zigmond is combined with Neel, Kitsukawa and Knudson, the result would still not disable a DTV function of outputting selected programs.

Further, the assertions made in the Office Action on pages 10-12 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2143 cannot be found. Additionally, since neither Zigmond, Neel, Kitsukawa, Knudson, and therefore, nor the combination of the four, teach, disclose or suggest all the limitations of Applicant's claims 1 and 12, as listed above, Applicant's claims 1 and 12 are not obvious over Zigmond and Neel in view of Kitsukawa, and further in view of Knudson since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claims 1 and 12 of the present application are patentable over Zigmond and Neel in view of Kitsukawa, and further in view of Knudson for at least the reasons set forth above. Additionally, the claims that directly or indirectly depend on amended claims 1 and 12, namely claims 5, 13 and 15, respectively, are also patentable over Zigmond and Neel in view of Kitsukawa, and further in view of Knudson for at least the same reasons as asserted above.

Accordingly, withdrawal of the rejections of claims 5, 12, 13 and 15 are respectfully requested.

Claims 9-11

Claims 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Neel in view of Gupta and Dimitrova. The rejection is respectfully traversed because for at least the following reasons, Zigmond, Neel, Gupta, Dimitrova, and any combination of the four

do not disclose all of the claimed limitations.

Applicant's claims 9-11 indirectly depend on amended claim 1. As asserted above, neither Zigmond, Neel, nor any combination, teach, disclose or suggest Applicant's amended claim 1 limitations. Gupta discloses insertion of advertisements while video content is not displayed and uses a timer and Dimitrova uses a temporal relationship policy using counters to determine type of advertisement.

No combinations of Zigmond, Neel, Dimitrova and even Gupta teach, disclose or suggest Applicant's amended claim 1 limitations of:

maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then *disabling the digital TV function of outputting the received video data* of the digital television receiver (emphasis added).

Further, the assertions made in the Office Action on pages 13-14 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2143 cannot be found. Additionally, since neither Zigmond, Neel, Dimitrova, Gupta and therefore, nor the combination of the four, teach, disclose or suggest all the limitations of Applicant's claim 1, as listed above, Applicant's claim 1 is not obvious over Zigmond and Neel in view of Dimitrova and Gupta since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claim 1 of the present application is patentable over Zigmond and Neel in view of Dimitrova and Gupta for at least the reasons set forth above. Additionally, the claims that indirectly depend on amended claim 1, namely claims 9-11, are also patentable over Zigmond and Neel in view of Dimitrova and Gupta for the same reasons as asserted above.

Accordingly, withdrawal of the rejections of claims 9-11 are respectfully requested.

Claim 14

Claim 14 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Zigmond, Neel and Knudson, in view of Gupta and Dimitrova. The rejection is respectfully traversed because for at least the following reasons, Zigmond, Neel, Knudson, Gupta, Dimitrova, and any combination of the four do not disclose all of the claimed limitations.

Applicant's claim 14 directly depends on amended claim 12. As discussed above, Zigmond in view of Neel and Knudson does not teach, disclose or suggest Applicant's amended claim 12 limitations of

an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for outputting the combined video output signal, wherein the selected program and rendered data are simultaneously output in the video output signal for simultaneously viewing the advertisement messages and the received video data, wherein *the disable signal disables output of selected programs* (emphasis added).

Gupta is relied on for disclosing a counter having a value that is incremented. Dimitrova is relied on for disclosing incrementing and decrementing a counter.

Even if Zigmond, Neel and Knudson are combined with Dimitrova and Gupta, the result would still not teach, disclose or suggest all the limitations in Applicant's amended claim 12 of,

an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for outputting the combined video output signal, wherein the selected program and rendered data are simultaneously output in the video output signal for simultaneously viewing the advertisement messages and the received video data, wherein *the disable signal disables output of selected programs* (emphasis added).

Further, the assertions made in the Office Action on page 16 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP §2143 cannot be found. Additionally, since neither Zigmond, Neel, Knudson, Dimitrova, and

Gupta, and therefore, nor the combination of the five, teach, disclose or suggest all the limitations of Applicant's claim 12, as listed above, Applicant's claim 12 is not obvious over Zigmond, Neel and Knudson in view of Dimitrova and Gupta since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claim 12 of the present application is patentable over Zigmond, Neel and Knudson in view of Dimitrova and Gupta for at least the reasons set forth above. Additionally, the claim that directly depends on amended claim 12, namely claim 14, is also patentable over Zigmond, Neel and Knudson in view of Dimitrova and Gupta for at least the same reasons as asserted above.

Accordingly, withdrawal of the rejections of claim 14 is respectfully requested.

CONCLUSION

For these and other reasons, it is respectfully submitted that the rejection of the rejected claims should be withdrawn, and all of the claims be allowed. Accordingly, reexamination, reconsideration and allowance of all the claims are respectfully requested. If the Examiner believes that a telephone interview will help further the prosecution of this case, Applicant respectfully requests that the undersigned attorney be contacted at the listed telephone number.

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Respectfully submitted,

/MZ/

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